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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

YOR920000563US1 / I27-0002

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Application Number

09/749,846

Filed

December 27, 2000

First Named Inventor

Mina L. McKay

Art Unit

3623

Examiner

S. Meinecke Diaz

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.

Registration number _____

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Marisa J. Dubuc
Signature

Marisa J. Dubuc

Typed or printed name

860-286-2929

Telephone number

July 27, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	MINA L. MCKAY ET AL.)	
)	Group Art Unit: 3623
Serial No.:	09/749,846)	
)	
Filed:	DECEMBER 27, 2000)	Examiner: S. MEINECKE DIAZ
)	
For:	METHOD AND SYSTEM FOR)	
	GATHERING AND)	Confirmation No.: 4804
	DISSEMINATING QUALITY)	
	PERFORMANCE AND AUDIT)	
	ACTIVITY DATA IN AN)	
	EXTENDED ENTERPRISE)	
	ENVIRONMENT)	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In response to the Final Office Action mailed February 27, 2006, and in conjunction with the concurrently filed Notice of Appeal, the Applicants submit the following for entry in the above-identified application.

REMARKS

Claims 1-3, 6-30, 33-37, 39-43, 46-70, 73-75 and 77-82 are pending in the instant application. Claim 2, 3, 16-24, 26-30, 33-35, 42, 43, 56-64, 66-70 and 73-75 have been withdrawn. Claims 1, 6-15, 25, 36, 37, 39-41, 46-55, 65 and 77-82 have been rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over U.S. Patent No. 6,154,753 to McFarland (hereinafter "McFarland") in further view of Bons et al. ("A Formal Specification of Automated Auditing of Trustworthy Trade Procedures for Open Electronic Commerce") (hereinafter "Bons"). The Applicants submit that the rejections of claims 1, 6-15, 25, 36, 37, 39-41, 46-55, 65 and 77-82 are in error because the Examiner has not met the burden of establishing a *prima facie* case of obviousness in contravention of the provisions of 35 U.S.C. 103.

With respect to claim 1, the Examiner states that the combination of McFarland and Bons teaches "receiving a request from a user system of an enterprise system to initiate an activity, said activity including scheduling an audit for performing an initial or ongoing qualification of an existing or prospective trading partner of the enterprise system", citing Figs. 1, 62, 65; col. 24, lines 20-30; col. 25, lines 33-34; col. 26, lines 5-15; col. 28, lines 28-30 of McFarland and pages 1-2, Abstract of Bons in support. The Applicants submit that Bons has been improperly applied as a reference. Bons relates to the secure transmission of electronic documentation and not to the field of supplier auditing and qualification as recited in the Applicants' claims. As such, the Bons is non-analogous art. Assuming for the sake of argument that Bons is analogous art, the Examiner has misconstrued the teachings of Bons with respect to Applicants' claim 1. Bons is directed to establishing ***trustworthiness of information exchanged*** among entities and is focused specifically upon the process by which documents are safeguarded in the transmission process. Bons does not teach any type of auditing with respect to the trading partners themselves.

In addition, with respect to claim 1, the Examiner states that McFarland teaches scheduling said audit includes: entering supplier data relating to the trading partner into a schedule form (Figs. 62-66; col. 24, lines 25-30; col. 26, lines 16-30); and entering requester information into said schedule form (Figs. 62-66; col. 24, lines 25-30; col. 26, lines 16-30). The Examiner has erred in this rejection because McFarland does not teach auditing activities

directed to trading partners. Moreover, Bons does not teach auditing activities or any type of scheduling form, but rather is directed to a method for establishing trustworthiness of information exchanged among trading partners as indicated above. The auditing discussed in Bons is focused on the process by which these documents are safeguarded. The Examiner states in the Final Office Action that the feature “entering supplier data relating to the trading partner into a schedule form” may be found in FIGs. 62-66; col. 24, lines 25-30; and col. 26, lines 16-30. However, these sections of McFarland simply refer to the entry of employee/auditor information in evaluating individuals within an organization for ISO compliance. In particular, column 24, lines 24-30 of McFarland teach a form whereby scheduling of internal or external auditors, audit date, scope of audit, departmental management identification, noncompliance counts, observation counts, audit type, documents to collect for review, checklists to generate, and corrective actions to validate are planned and documented. The information entered in that form is *entirely directed to auditing information, rather than the requester information or the operator information*. Further, Col. 26, lines 26-29 of McFarland teaches that in fields “employee, manager” at 636, and fields “iaext” and “mgrext” at blocks 638 and 640, the operator must enter the data relating to the identity of the auditor and the internal auditors phone, as well as the managers telephone. *There is no disclosure in McFarland that the operator enters the information about the operator*. Thus, McFarland fails to teach or suggest the element “entering requester information into said schedule form”, as recited in Claim 1.

Thus, neither McFarland nor Bons, either alone or in combination teaches each of the features recited in claim 1. Accordingly, clear error exists in the outstanding rejection of claim 1. Moreover, in the Final Office Action dated February 27, 2006, the Examiner relies extensively on Official Notice in his rejections of claim 1, 8, 10, 11, 12, 14, and 15. The Examiner’s use of Official Notice in these circumstances is improper. MPEP § 2144.03 defines when it is proper to use Official Notice. In particular, the MPEP states “Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.” The MPEP also states “It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.” In

this case, the Examiner has heavily relied upon Official Notice for features that are not capable of instant and unquestionable demonstration as being well-known. Features recited in Applicants' claims directed to: utilizing a website for qualifying suppliers; database access system procedures; auditing an engineering and development group; facilitating the acceptance/rejection of tasks by project management; facilitating the process of providing secondary support (back-up) for tasks; specifying audit intervals; filtering audit information using conditions, etc. have all been rejected under Official Notice without any documentary support provided by the Examiner. For the reasons presented above, the Applicants submit that clear error exists in the claims rejected under Official Notice.

Since they contain similar features, the Applicants submit that clear error exists in the rejections of claims 25, 36, 41, and 65 for the reasons stated above with respect to claim 1.

In view of the foregoing, it is urged that the final rejection of claims 1, 6-15, 25, 36, 37, 39-41, 46-55, 65 and 77-82 be overturned. The final rejection is in error and should be reversed. The fee set forth in 37 CFR 41.20(b)(1) is enclosed herewith. If there are any additional charges with respect to this Request, or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

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